

REMARKS

Claims 11-37 are pending in this application. Of these, the Office Action rejects Claims 11-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,647,260 to Dusse et al. (hereinafter the “Dusse patent”) in view of U.S. Patent Application Publication No. 2002/0049717 to Routtenberg et al. (hereinafter the “Routtenberg publication”).

Claims 11, 14, 16, 31 and 33-37 have been amended. Claims 38-40 have been added. No new matter has been added by the amendment. In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application, namely Claims 11-40.

Independent claim 11 recites, *inter alia*, temporarily saving the media content within the mobile station, and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content, and permanently saving said media content within said mobile station only when permission to save has been received from said server. Thus, according to an embodiment as recited in independent claim 11, the same media content that is requested is temporarily saved and a portion of the same media content, more specifically a portion that was itself specifically requested, is previewed. In other words the embodiment of claim 11 requires that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station. Additionally, the media content is permanently saved within the mobile station only when permission to save has been received from the server.

Initially, Applicant notes that the Office Action acknowledges that the Dusse patent fails to teach or suggest “permanently saving said media content within said mobile station only when permission to save has been received from said server” (emphasis added), and as such relies on the Routtenberg publication for overcoming this deficiency of the Dusse patent. Although the

Office Action alleges that “the combination the content storage device [106] with the content access device [104] performs the functionalities of the mobile station”, the Office Action also alleges that “Routtenberg teaches permanently saving (permanently writing) the media content within the mobile station (within a DSM of a content access device 104)”. Accordingly, although the Office Action acknowledges that the media content is actually written to the DSM, the Office Action appears to confuse two distinct embodiments of the Routtenberg publication.

In this regard, with respect to a first embodiment wherein the content storage device is combined with the content access device, the content has already been transferred to the storage device in its entirety but has been encoded to limit user access to only a portion of the transferred content. See paragraphs 36 and 40 of the Routtenberg publication. As such, full access (decoding of the entire media content) is only given when the server successfully bills the user, although the content, in its entirety, has already been transferred to the content storage device. See paragraph 42 of the Routtenberg publication. Therefore, the Routtenberg publication discloses that the content is transferred to the content storage device in its entirety even before receiving any indication of successful billing from the server. Accordingly, the Routtenberg publication does not teach or suggest “permanently saving said media content within said mobile station only when permission to save has been received from said server” because the content has already been transferred to the content storage device in its entirety, although not completely decoded.

With respect to the second embodiment of the Routtenberg application, Applicant respectfully disagrees with the statement of the Office Action asserting that “Routtenberg teaches permanently saving (permanently writing) the media content within the mobile station (within a DSM of a content access device 104)”. Applicant notes that the DSM is not associated with content access device 104 (of the first embodiment) but rather Digital Audio Player 124. Moreover, the second embodiment is separate and completely distinct from the first embodiment and involves the use of a DSM (which is described as, for example, a CD or DVD). The DSM is in any case “removable” and “self-contained” in addition to being inter-operable with other

devices. See paragraph 48 of the Routtenberg publication. As such, the DSM may be removed from the digital audio player 124 and inserted into another media playing device, such as a CD or DVD player. Thus, it is clear that the DSM is not usable for permanently saving content within the digital audio player 124 or any other device because the DSM does not permanently reside on the digital audio player 124 or any other device. Accordingly, any combination of the Dusse patent and the Routtenberg publication fails to teach or suggest “permanently saving said media content within said mobile station only when permission to save has been received from said server”, as recited in the claims.

Moreover, the Dusse patent discloses that the provisioning server may receive a request from the user for desired features to be transferred to the user device, and after verifying the user information from the request, the provisioning server may push terms, conditions, and related information to the requesting mobile for user approval. See col. 8, lines 14-24 of the Dusse patent. The Office Action alleges that this step discloses “temporarily saving said media content within said mobile station”, as recited in the claims. Additionally, the Office Action asserts that the “[provisioning] content and related notifications combined are considered as ‘media content’.” However, the provisioning content and related notifications are forwarded to the mobile device only if the user approves of the terms, conditions, and related information, despite the fact that the provisioning content was originally requested by the user. See col. 8, lines 35-44 of the Dusse patent. As such, the Dusse patent cannot teach or suggest “temporarily saving said media content within said mobile station” because the provisioning content and related notifications are actually not sent to the mobile station until the user approves the terms, conditions, and related information. It follows that the Dusse cannot teach or suggest “previewing at least a portion of said media content on said mobile station” as further recited in the claimed invention.

By contrast, the Routtenberg publication discloses that content files are written to the DSM solely based on whether “the server 102 was successful in billing the user”. See paragraph 42 of the Routtenberg publication. As such, regardless of whether user approval has been

received after the selection of desired content files for which full access is requested, the content files are written to the DSM only if the server has successfully billed the user. Accordingly, an ordinary person skilled in the art would not combine the Dusse patent with the Routtenberg publication because doing so would obviate the requirement for user approval specifically disclosed by the Dusse patent. In the alternative, any combination of the Dusse patent with Routtenber, even if possible, would require two conditions which must be satisfied prior to permanently writing any content, namely 1) user approval of some terms and conditions, and 2) the server successfully billing the user.

Additionally, the Dusse patent and the Routtenberg publication, individually or in combination, fail to teach or suggest “verifying a format of said file”, as recited in independent Claim 16. Indeed, the Office Action fails to identify any disclosure in the Dusse patent or the Routtenberg publication teaching or suggesting the verifying step because there is no such disclosure in the Dusse patent or the Routtenberg publication. By contrast, various claims recite a step of verifying the format of the file. In this regard, the present application discloses that the file received by the mobile station may include multiple content types. See paragraph 158 of the present application. For example, five ring tunes or a combination of ring tunes and bitmaps may be downloaded in the same file. See paragraph 158 of the present application. As such, the mobile station verifies the data format to identify the one or more content types of the received file.

Independent Claim 11 has been amended to recite “verifying a format of said media content” and “temporarily saving said media content within said mobile station based on the format of said media content.” Independent Claims 31 and 36 have been similarly amended. As mentioned above, the Dusse patent and the Routtenberg publication, individually or in combination, fail to teach or suggest verifying a format of the media content.

Additionally, independent Claim 16 has been amended to recite “receiving compensation based on the usage record.” Independent Claims 33, 34, 35, and 37 have been similarly

amended. In this regard, the present application discloses that the user may receive digital cash or credit on the user's bill based the usage of the media (e.g., playing a ring tune). The Dusse patent and the Routtenberg publication, individually or in combination, fail to teach or suggest "receiving compensation based on the usage record."

Accordingly, Applicant submits that independent Claims 11, 16, 31 and 33-37, and the claims respectively depending therefrom, namely Claims 12-15, 17-30 and 32, are patentable over the Dusse patent and the Routtenberg publication, alone or in combination.

With respect to the dependent claims, Applicant initially notes that the dependent claims include recitations of respective independent claims and are patentably distinct for at least the same reasons described above. Additionally, a number of the dependent claims include additional recitations that are also not taught or suggested by the cited references and which therefore provide additional bases of patentability. For example, with respect to Claims 13 and 14, the Office Action cites various passages in the Dusse patent as disclosing the subject matter recited the claims. However, the cited passages are only directed to changes to features or services transferred to the device. The Dusse patent does not disclose monitoring the usage of the features or services. Accordingly, the Dusse patent cannot teach or suggest "sending a message from said mobile station to said server to update a usage record employing said reply URL when said mobile station uses said media content" as recited in Claim 13 or "receiving a bill indicating use of said media content by said mobile station" as recited in Claim 14.

Moreover, with respect to Claim 27, the Office Action acknowledges that the Dusse patent and the Routtenberg publication do not disclose "listening to said ring tune", as provided in Claim 27. However, the Office Action alleges that the user approval of the terms and conditions disclosed by the Dusse patent "amount[s] to previewing" and that "'listening' is previewing." However, as mentioned above, the Dusse patent fails to teach or suggest

Appl. No.: 09/746,270
Filed: December 20, 2000
Amdt. dated 12/23/2008

previewing. Accordingly, the Dusse patent does not teach or suggest each and every element of Claim 27.

Claims 38-40 have been added. The new claims include no new matter and are fully supported by the specification of the present application, for example, at paragraphs 158, 174 and 180.

For all the reasons above, Applicant respectfully submits that independent claims 11, 16, 31 and 33-37 are patentable over the Dusse patent and the Routtenberg publication, alone or in combination. Claims 12-15, 17-30 and 32 depend directly or indirectly from independent claims 11, 16 and 31, respectively, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 12-15, 17-30 and 32 are patentable for at least the reasons given above for independent claims 11, 16 and 31.

Accordingly, for all the reasons stated above, Applicant respectfully submits that the rejections of claims 11-37 are overcome.


CONCLUSION

In view of the amendment and remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'James S. Bennin', with a horizontal line drawn underneath it.

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ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON December 23, 2008.

LEGAL02/31078529v1